

The following was stated responding to both the rejection over the Develter '226 patent and the rejection over the '902 Merciadet et al. patent, in the Amendment responding to the Office Action of November 26, 1999:

Applicant's invention involves an unexpected, surprising and unusual result that is not shown in the prior art and was not obvious to one having ordinary skill in the art. This invention clearly meets the patentability requirements set forth in 35 U.S.C. §103(a)

This position, which is the lynchpin of Applicant's argument was not responded to in the "Response to Arguments" portion of the FINAL rejection dated May 9, 2000.

Applicant's specification contains more than a mere argument or conclusory statement that his invention produces results that are new and unexpected, rather Applicant has provide in his specification hard evidence of his new and unexpected results. Applicant's specification contains the results of comparative tests on the one hand showing the results of what one of ordinary skill in the art would expect and, on the other hand, the new and unexpected results that are obtained as a result of Applicant's invention. The specification of the subject application, as originally filed, contains the evidence that the claimed invention yields new and unexpected results. This evidence clearly rebuts the *prima facie* case of obviousness upon which both rejections of claims 1 and 2 are based.

In Figures 1-4, Applicant has provided photographic proof of what is expected by one having ordinary skill in the art when a steel bar is exposed to tap water, and the new and unexpected results that are obtained when the same type of steel bar is exposed to Applicant's PS solution. In Figures 5-7, Applicant has provided the EDS spectra for the steel bars shown in Figures 1-4. In Figure 8, Applicant has provided the EDS spectra for a sample steel bar that was not exposed to the corrosion test.

However, the most spectacular evidence of the new and unexpected results of Applicant's invention is presented in Figures 9-17. Figures 9-16, which are color photographs, show in side-by-side glass containers the results of a 7-day experiment. The container on the left contained tap water and the container on the right contained Applicant's PS solution. Ungalvanized nails were submerged in the liquid of both containers and color photographs were taken as the test progressed. The nails,

RECEIVED
JUL 25 2000
1700 A-1-1000N

removed from the containers, are shown in Figure 17 after the conclusion of the experiment. In this series of colored photographs, there is shown what one having ordinary skill in the art expects when ungalvanized nails are exposed to tap water and also shows the new and unexpected results that are the results when ungalvanized nails are exposed for the same period in Applicant's PS solution. Thus, Applicant has provided, in the application as originally filed, a baseline of expected results against which to measure the observed improvements of Applicant's invention. The evidence presented in this application of Applicant's new and unexpected results has not been disproven or even challenged by the prior art applied against claims 1 and 2 in the rejections.

The evidence presented in this application has obviously not been given the consideration that it deserves. When this evidence is considered, as it must be in compliance with the law, Applicant's invention, as recited in claims 1 and 2, is not obvious over the applied references.

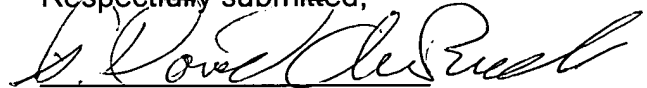
Reference is hereby made to *In re Soni*, 34 USPQ2d, 1684. In this case, the U.S. Court of Appeals Federal Circuit reversed the decision of the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences. In this decision, the majority opinion held that the specification contained more than mere argument or conclusory statements of new and unexpected results; it contained specific data indicating improved properties. Judge Michel wrote a dissenting opinion. In his dissent, it is stated that one way for an Applicant to satisfy the burden of coming forward with evidence to rebut the *prima facie* case of obviousness is to demonstrate that the claimed invention yields unexpected results. It was Judge Michel's opinion that *Soni* had failed to come forward with factual evidence tending to establish the unexpected results. Judge Michel points out that *Soni* failed to establish a baseline of expected results against which to measure the observed improvements. It was his further opinion that, without such a baseline, unexpected results cannot be proven. Applicant has

provided a baseline showing what one having ordinary skill in the art would expect when ungalvanized nails are placed in tap water along side of the evidence showing the new and unexpected results that are obtained as a result of his invention. . Thus, it is submitted that both the majority and the dissenting minority in the *Soni* Court would find in favor of Applicant in this application.

Reconsideration and allowance of this application are respectfully requested.

Dated: June 28, 2000

Respectfully submitted,



F. David AuBuchon

Reg. No. 20,493

Attorney for Applicant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
Chicago, Illinois 60610
(312) 321-7738